



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/678,752      | 10/03/2000  | James D. Shaffer     | TARINFO.016A        | 5520             |

20995 7590 10/18/2004

Knobbe Martens Olson & Bear LLP  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614

EXAMINER

JEANTY, ROMAIN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3623

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/678,752

Applicant(s)

SHAFFER ET AL. *SH*

Examiner

Romain Jeanty

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-140 is/are pending in the application.
- 4a) Of the above claim(s) 1-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-140 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Claims 1-8, 38-45 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on June 7, 2004.

***Claim Rejections - 35 USC § 103***

2. - The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 57-140 are rejected under 35 U.S.C. 103(a) as being unpatented over Bates et al "Bates" (U.S. Patent No. 6,247,043) in view of Kinra (U.S Patent No. 5,731,991).

As per claims 57, 59, 62-63, 66-68, 70-140, Bates disclose a method of implementing various intelligent contact management comprising:

interactively generating a list specification in real-time, interactively specifying a geographically defined area for which a contact list is desired including receiving user input (col. 9, lines 5-30), and

transmitting the list specification over the computer network to a server having a memory (col. 10, lines 7-12);

building the contact list on the server in real-time based on the list specification, and transmitting the contact list to a user-specified node on the computer network if one or more characteristics of the contact list are approved by a user (col. 11, lines 1-14; col. 18, line 58 through col. 19 line14). Bates does not explicitly disclose interactively selecting a product from a

Art Unit: 3623

plurality of products and a threshold score for the product including receiving user input. Kinra on the other hand, discloses the idea of selecting a product and a value (threshold) for the product (col. 1, lines 50-61). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the disclosures of Bates to incorporate the teachings of Kinra. A person having ordinary skill in the art would have been motivated to use such a modification so that the product can be evaluated according to the needs or requirements of a specific user.

As per claim 58, Bate further discloses wherein the characteristics of the contact list include a number of names/records on the contact list, the list specification for the contact list and a cost of the contact list (col. 7, line 65 through 8 line 5).

As per claim 60, Bates further discloses storing the list specification in a memory (col. 9, lines 5-30), and it is inherent to rebuilding the contact list at a predetermined future time based on the stored list specification.

As per claim 61, Bates further discloses wherein the stored list specification corresponds to a selected business location of a multiple location business (col. 11 lines 53-67).

As per claims 64-65, Bates disclose the method defined in Claim 57, wherein nteractively generating a list specification in real-time is performed on a user specification node on the computer network . Note FIG 2, element 38).

Claim 69 recites the same limitations in claim 57 above; therefore is rejected under the same rationale.

### **Conclusion**

Art Unit: 3623

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Robertson et al (U.S. Patent No. 6,714,916) discloses a computer software used to manage contact information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached on Mon-Thurs 7:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RJ

9/7/04



ROMAIN JEANTY  
PRIMARY EXAMINER

Art Unit 3623